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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,553	01/23/2006	Mitsuhiro Kaneta	Q92827	2076
65565 7590 08/05/2009 SUGHRUE-265550 2100 PENNSYLVANIA AVE. NW WASHINGTON, DC 20037-3213				
EXAMINER BERNSHTEYN, MICHAEL				
ART UNIT		PAPER NUMBER		
1796				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/565,553

**Applicant(s)**

KANETA, MITSUHIRO

**Examiner**

MICHAEL M. BERNSTEYN

**Art Unit**

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is a response to the remarks filed on May 18, 2009. No claims have been amended, cancelled or added.
2. Claims 1-3 are pending.

### ***Claim Rejections - 35 USC § 103***

3. The text of this section of Title 35 U.S.C. not included in this action can be found in a prior Office Action.
4. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Catena (U. S. Patent 5,256,450) in view of Reich (U. S. Patent 5,350,783), for the rationale recited in paragraph 1 of Office action dated February 18, 2008 and comments below.

### ***Response to Arguments***

5. Applicant's arguments filed on May 18, 2009 have been fully considered but they are not persuasive.
6. It appears that the focal applicant's argument resides in the contention that there is no sufficient teaching, suggestion, motivation, or other reason to combine Catena with Reich, and that person of ordinary skill in the art would have recognized that Na is an alkali metal that typically carries a single positive charge, whereas Ca and Mg are alkaline earth metals that typically carry a double positive charge. This same general

argument applies to the rest of the recited non-alkali metals of claim 3 or the non-alkali metals recited by Reich (page 2, 2<sup>nd</sup> paragraph).

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references belong to the same field of endeavor and teach thermoplastic polymer products comprising promoting agent selected from the group consisting of metal complexing agents.

It is noted that as it was already mentioned in the previous Office Action dated February 18, 2009, Reich discloses that metal complexing agents include complexes of nonoxidizing metals such as aluminum, barium, calcium, magnesium, potassium, sodium, and titanium, preferably those of sodium, calcium, potassium, and magnesium. The metal complexes are neither prooxidants nor photoactivators and include sodium ethylenediaminetetraacetate, sodium salt of zinc ethylenediaminetetraacetate, calcium diethyldithiocarbamate, magnesium hydroxyethylethylenediaminetriacetic acid, sodium salt, calcium acetylacetonate, magnesium triethylenetetraaminetetraacetate, zinc diethylenetriamine pentaacetic acid, sodium salt, potassium propylenediaminetetraacetate, and nonoxidizing metal complexes of cyclic phosphate,

xanthates, benzothiazoles, oximes, and benzimidazoles (col. 4, line 63 through col. 5, line 9).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute tetrasodium ethylenediaminetetraacetate of Catena for metal complexes of nonoxidizing metals such as aluminum, barium, calcium, magnesium, potassium, sodium, and titanium, preferably those of sodium, calcium, potassium, and magnesium as taught by Reich based on their recognized equivalency and with the reasonable expectation of success, and this to arrive the subject matter of instant claims 1 and 3.

It is further noted that "The motivation in the prior art to combine references does not have to be identical to that of the applicant to establish obviousness, i.e. it is not required for a finding of obviousness that motivation of the skilled artisan be the same as an applicant motivation", *In re Kemps*, 97 F.3d 1427, 1430, 40 USPQ2d 1309, 1312 (Fed. Cir. 1996) (holding there is sufficient motivation to combine teachings of prior art to achieve claimed invention where one reference specifically refers to the other).

Therefore, it is well settled that for a finding of obviousness under § 103 the prior art need not disclose the same motivation as disclosed by an applicant.

8. Applicants contend that there is no proper teaching, suggestion, motivation, or other reason to substitute the Fe, Cu, Mg, Co, Cr, Ni, V, or Zn complexes of Reich into the Na EDTA of Catena, and second, a person of ordinary skill in the art would not have combined Catena with Reich, because the teachings of Catena and Reich discourage such a combination. Catena is directed toward a sealant with good heat resistance and

low shrinkage for porous materials, such as metal while Reich is directed toward a composting agent that uses EDTA as a complexing agent to release "active oxidants which degrade the polymer to a low molecular weight biodegradable material" (pages 2-3, the bridging paragraph).

9. It is noted that Reich discloses that it has been found that certain additives can be added which are polymeric composting promoting agents and which do not prematurely degrade the thermoplastic polymer during processing, indoor and outdoor storage, and use. In this invention, polymeric composting promoting agents include nonmetallic metal complexing agents, nonoxidizing-metal metal complexing agents, and mixtures thereof (col. 4, lines 8-12).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute tetrasodium ethylenediaminetetraacetate of Catena for metal complexes of nonoxidizing metals such as aluminum, barium, calcium, magnesium, potassium, sodium, and titanium, preferably those of sodium, calcium, potassium, and magnesium as taught by Reich because such additives do not prematurely degrade the thermoplastic polymer during processing, indoor and outdoor storage, and use with enhanced biodegradability (US'783, col. 4, lines 8-12 and 22-23).

10. In response to applicant's argument that the references fail to show certain features of applicant's invention (page 4, 2<sup>nd</sup> paragraph), it is noted that the features upon which applicant relies (i.e., curing acceleration lower preservability) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **MICHAEL M. BERNSHTEYN** whose telephone number is (571)272-2411. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael M. Bernshteyn/  
Examiner, Art Unit 1796

/M. M. B./  
Examiner, Art Unit 1796

/David Wu/

Supervisory Patent Examiner, Art Unit 1796